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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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11/07/2001

Michel Maillard

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,587

Applicant(s)

MAILLARD, MICHEL

Examiner

Pramila Parthasarathy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 10,11,16,18-20,26,27,29,30,32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9,12-15,17,21-25,28 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

2. Applicant's submission filed on April 06, 2006 has been entered and made of record.

Claim Objections

3. The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (See § 1.58(a).)

Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

- (1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,
- (2) A phrase such as “wherein the improvement comprises, ” and
- (3) Those elements, steps, and /or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

Independent Claims 1 and 21 do not have the separation of the phrase “...comprising:” separating the limitations with the preamble, specifically “:” (**emphasis added**).

For examination purposes, Examiner reads, “A method ofdecoder, said at least one key pair **comprising:**” and “A digital ...precalculated key pair **comprising:**” (emphasis added), as preamble to the claims 1 and 21 respectively.

4. Claims 2- 5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Independent Claim 1 recites, “...wherein **at least one precalculated key pair is stored in a memory of the first decoder,...**”. Dependent Claim 2 recites, “A method as claimed in Claim 1, in which **a plurality of key pairs are stored in the memory of the first decoder, ...**” (**emphasis added**). Dependent Claim 2 does not further limit the subject matter of the independent claim 1, on which Claim 2 depends on.

Dependent claims 3 – 5 are objected as they depend on objected claim 2.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-9,12-15,17,21-25,28 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 23 of U.S. Patent No. 6,286,103. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 1 – 23 of Patent # 6,286,103 contains every element of amended Claims 1-9,12-15,17,21-25,28 and 31 of the instant application and as such anticipates amended Claims 1-9,12-15,17,21-25,28 and 31 of the instant application.

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Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326, 52 USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. Id. at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double patenting. In re Berg, 140 F.3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998). A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP 804.

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6. Amended Claims 1-9,12-15,17,21-25,28 and 31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 – 20 and 30 – 36 of copending Application No. 09/622,137. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 4 – 20 and 30 – 36 of copending Application No. 09/622,137 contains every element of amended Claims 1-9,12-15,17,21-25,28 and 31 of the instant application and as such anticipates amended Claims 1-9,12-15,17,21-25,28 and 31 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 2 – 5 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Claims 2 and 22 recites, "generate a definitive session key" and the term "definitive", which is not defined by the claim, the specification does not disclose generating a definitive session key, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Examiner interprets broadly as "generate a session key" for examination purposes.

The dependent claims 2 – 5 are rejected at least by virtue of their dependency on the dependent claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-9,12-15,17,21-25,28 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "equivalent" in claims 1 and 21 is a relative term, which renders the claim indefinite. The term "equivalent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The dependent claims 2 – 9, 12 – 15, 17, 22 – 25, 28 and 31 are rejected at least by virtue of their dependency on the dependent claims.

Response to Arguments

9. Applicant's arguments with respect to claims 1-9,12-15,17,21-25,28 and 31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9,12-15,17,21-25,28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al. (U.S. Patent Number 6,178,244) in view of Ganesan (U.S. Patent Number 5,748,735).

11. Regarding Claims 1 and 21, Takeda teaches a session key and an encrypted version of the session key prepared using a transport key, and communication means for communicating the encrypted version of the session key to said portable security module, said portable security module comprising memory for storing an equivalent transport key (Takeda Summary and Column 8 lines 55 – 64),

decryption means for decrypting said encrypted version of the session key using said equivalent transport key, and means for encrypting data to be communicated to said first decoder using said session key (Takeda Summary and Column 8 line 55 – Column 9 line 16).

Takeda does not explicitly teach the portable security module. However, Ganesan discloses a method for providing a smart card to store private key (session key) to facilitate secure storing of session keys (Ganesan Column 12 lines 19 – 31). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine a method for implementing a portable security module through which user can store the session key and encrypting data to be communicated as taught by Ganesan to provide a secure, selective encrypting information, as taught by Takeda.

12. Claims 2 and 22 are rejected as applied above in rejecting claims 1 and 21. Furthermore, Takeda teaches selecting and processing at least one session key to generate a definitive session key said communication means being adapted to communicate the associated encrypted version of said at least one session key to the portable security module, said portable security module comprising means for processing said at least one session key to generate the definitive session key (Takeda Column 9 line 30 – Column 10 line 2).

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13. Claim 6 is rejected as applied above in rejecting claim 1. Furthermore, Takeda teaches at least one precalculated key pair is selected from a large set of precalculated key pairs prior to being stored in the first decoder (Takeda Column 18 lines 41 – 62).

14. Claims 7 and 23 are rejected as applied above in rejecting claims 1 and 21. Furthermore, Takeda teaches the encrypted version of a session key communicated to the portable security module also includes a signature value readable by the portable security module to verify the authenticity of the encrypted version of the session key (Takeda Column 10 lines 6 – 42).

15. Claims 8 and 24 are rejected as applied above in rejecting claims 1 and 21. Furthermore, Takeda teaches an algorithm and transport key used to encrypt and decrypt a session key correspond to a symmetric algorithm and associated symmetric key (Takeda Column 19 lines 45 – 50).

16. Claims 9 and 25 are rejected as applied above in rejecting claims 1 and 21. Furthermore, Takeda teaches an algorithm used with a session key to encrypt and decrypt data communicated between the first decoder and the portable security module corresponds to a symmetric algorithm (Takeda Column 19 lines 45 – 67).

17. Claim 14 is rejected as applied above in rejecting claim 1. Furthermore, Takeda teaches data encrypted and decrypted with the session key correspond to control word data (Takeda Column 19 lines 45 – 67).

18. Claim 15 is rejected as applied above in rejecting claim 1. Furthermore, Takeda teaches data encrypted and decrypted with a session key corresponds to descrambled broadcast data (Takeda Column 19 lines 45 – 67 and Column 24 lines 11 – 15).

19. Claims 17 and 31 are rejected as applied above in rejecting claims 1 and 21. Furthermore, Takeda teaches a home network system, wherein the first decoder and the portable security module correspond to consumer electronic devices adapted to transfer data via a communication link (Takeda Column 19 lines 45 – 67 and Column 24 lines 11 – 15).

20. Claims 12 and 28 are rejected as applied above in rejecting claims 1 and 21. Furthermore, Takeda in view of Ganesan teaches the portable security module corresponds to one of a smart card and a conditional access module (Ganesan Column 12 lines 19 – 31).

21. Claim 13 is rejected as applied above in rejecting claim 1. Furthermore, Takeda teaches the first decoder corresponds to a conditional access module and the portable security module corresponds to a smart card (Ganesan Column 12 lines 19 – 31).

22. Claim 3 is rejected as applied above in rejecting claim 2. Furthermore, Takeda teaches a subset of a plurality of stored session keys is chosen by the first decoder to generate the definitive session key, the associated encrypted versions of the subset of session keys being communicated to the portable security module for decryption and processing (Takeda Column 19 lines 45 – 50 and Ganesan Column 12 lines 19 – 31).

23. Claim 4 is rejected as applied above in rejecting claim 2. Furthermore, Takeda teaches the order of combination of a plurality of session keys used to generate the definitive session key is communicated from the first decoder to the portable security module (Takeda Column 19 lines 45 – 50 and Ganesan Column 12 lines 19 – 31).

24. Claim 5 is rejected as applied above in rejecting claim 4. Furthermore, Takeda teaches an initial session key value known to both the first decoder and the portable security module is repeatedly encrypted in both devices by an ordered sequence of session keys using an encryption algorithm sensitive to the order of encryption (Takeda Column 19 lines 45 – 50 and Ganesan Column 12 lines 19 – 31).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz

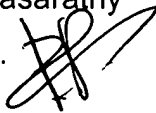
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Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

May 26, 2006.



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